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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JOHNSON, BLAIR M

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/205,318

Applicant(s)
Lapage et al

Examiner
Blair M. Johnson

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3634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 13, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. Claims 20-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

There are three related features which appear in the patented claims and have been modified or removed from new claims 20-27. The first feature involves the preamble of patent claim 1 which recites a closure device "typically for use on vehicle shelters". However, during prosecution of the now patent, the Examiner made it clear in his action of 11-17-95 (first and only office action) that he considered the invention to be directed only to the closure and that the vehicle shelter was not being claimed. Applicant has omitted this functional recitation from the new claims. Since the Examiner did not view this functional recitation as limiting, the omission of this feature now does not constitute an attempt to recapture. However, Applicant uses this feature as a reason for his original claiming of the second and third features, namely the diverging sides of

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the closure and the diverging guide means, both of which are clearly recited in claim 1 of the patent. The question to be asked regarding the issue of recapture is: Were these limitations of the diverging sides and guide means necessary for patentability? Upon reading Applicant's remarks beginning on page 5 of Applicant's response of 5-30-96 (first and only response), it is clear that the "diverging" feature is at the point of novelty. (Note that on page 5, Applicant appears to agree with the Examiner that the vehicle shelter is not being recited when he states that certain amendments to claim 1 were made to "remove therefrom any limitation of the claimed closure device related to the vehicle shelter". Further, nowhere in his address of the prior art, none of which deals with vehicle shelters, does he argue the shortcomings of the prior art due to this lack of environmental teaching.)

Regarding the Belgian patent to Wellens, he states on page 6, lines 13-15, that "In the present invention, the section closing the trapezoidal opening is complementary in shape thereto and thus cannot be fairly compared to the Wellens system", the Wellens system which includes a screen which is "*vertically* guided along guide tracks", page 6, line 1, emphasis **not** added. He further states: "In fact, Claim 1 is considered to clearly distinguish from the Belgium Patent by claiming that the section of the flexible closure closing the shelter opening has side edges tapering towards the overhead roller provided at the narrow end of the shelter opening", page 6, lines 15-19. This is a clear indication that Applicant fully considered that the "diverging" feature rendered his claim allowable.

Regarding Applicant's remarks concerning both Ojima et al and German patent

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No. DE-38 41 139-A, he further stresses the level of importance of the “diverging” feature to overall patentability by stating that while these references do have diverging sides and guides, they differ in other structural ways, i.e. location of the roller. He states on page 7, lines 6-8, that these two references show the roller at the “large end of a trapezoidal opening as opposed to the device of the present invention which is, and must, be installed at the narrow end thereof”, emphasis **not** added. Again, emphasis is put on the patentability of the “diverging” feature.

Regarding German, he again states that the closure is a “constant span”, emphasis **not** added, and also addresses the “large” end verses the “narrow” end of the opening, as discussed above.

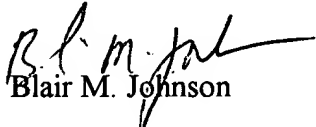
On page 8, Applicant summarizes his view of the patentability of claim 1 over the prior art as being attributable to the “tapering section”, the prior art having “rectangular” closures, etc.

Consequently, it is clear from the specifics discussed above, as well as from the general view expressed by Applicant in the remarks of 5-30-96, that the diverging sides of the closure and the diverging guide means are the primary, and essentially only, feature which renders the claims allowable. Removing these features from the claims would be an attempt to recapture claimed subject matter.

2. The following is an examiner's statement of reasons for allowance of claims 20-27 over the prior art of record: the prior art does not teach lateral stretching elastic members or laterally inwardly biasing means being moveable with the curtain.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."



Blair M. Johnson

Primary Examiner
Art Unit 3634

January 24, 2003
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